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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,452	03/26/2004	David W. Galloway	1821-001-03	4007

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Mr. Stephen M. Evans
GRAYBEAL JACKSON HALEY LLP
Suite 350
155 - 108th Avenue NE
Bellevue, WA 98004-5901

EXAMINER	
CORBIN, ARTHUR L	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/811,452	GALLOWAY, DAVID W.	
	Examiner	Art Unit	
	Arthur L. Corbin	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,20-22 and 24-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,20-22 and 24-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. In view of the Appeal Brief filed on May 22, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***. For M. Cano

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 is indefinite in reciting the units "g/cm" as a measure of gel strength, which can be corrected by using "g.cm" as the units, as indicated by the article submitted with the October 11, 2005 response.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devro taken with or without Kojima et al. With Kojima et al, applicant is referred to the paragraph bridging pages 2 and 3 of the July 12, 2005 Office action. Without Kojima et al, finding the optimum film thickness would require nothing more than routine experimentation by one reasonably skilled in this art. Further, the collagen used for the film in Devro is a protein which is often derived from animal muscle tissue (claim 2).

6. Claims 4-9, 20-22 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devro taken with or without Kojima et al as applied to claims 1 and 2 above, and further in view of the Food Packaging Technology reference for the reasons set forth on pages 4-5 of the July 12, 2005 Office action. Additionally, applicant is referred to page 3 of said Office action for a discussion of how Devro discloses the limitations of applicant's claims 4, 5 and 6.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devro taken with or without Kojima et al and the Food Packaging Technology reference as applied to claims 4-9, 20-22 and 24-30 above, and further in view of Fetzer et al for the reasons set forth in the paragraph bridging pages 3 and 4 of said Office action.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devro taken with or without Kojima et al and the Food Packaging Technology reference as applied to claims 4-9, 20-22 and 24-30 above, and further in view of Nakajima for the reasons set forth in the first full paragraph on page 4 of said Office action.

9. The disclosure is objected to because of the following informalities: Applicant is referred to the second paragraph on page 2 of the July 12, 2005 Office action. This can be corrected by changing the units of gel strength to "g.cm".

Appropriate correction is required.

10. Applicant's arguments filed May 22, 2006 have been fully considered but they are not persuasive. The fact that Devro discloses that the films prepared therein are "generally undetectable", as applicant argues, does not patentably distinguish applicant's 1mm thin films (claims 1, 2, 8 and 9) or the films of claims 3-7, 20-22 and 24-30 thereover. Applicant's inference in this regard is without merit, especially since the integrity of Devro's film is maintained during cooking (page 4, lines 30-33). The film obviously must have sufficient thickness to meet this objective. Applicant's further argument to support his inference is that Devro's film is transparent (page 6 of brief). This conclusion by applicant is unsupported by the disclosure of Devro and is thus without merit. Additionally, even if the film of Devro's film is considered as being "very thin", as applicant contends, a 1mm thin film, as claimed by applicant, is within the realm of "very thin" and is not contrary to Devro's film.

Applicant's additional allegation with respect to Devro's film is that it is composed of collagen, which appellant contends is not derived from muscle tissue (applicant's

claim 2). This belief by applicant is ill founded since collagen is a protein which indeed may be derived from muscle tissue.

Applicant's remarks regarding the rejection of claims 20 and 26 and the claims dependent thereon are not convincing. The limitations of "prior to and during subsequent curing" (claim 20) and of "laid up in respective first and second concave molds during presetting" (claim 28) are method limitations which can be accorded no patentable weight in applicant's product claims. Further, joining preset films and subjecting them to a subsequent cure, which applicant argues (page 8 of brief) is a patentably distinguishing feature of the claimed invention in claims 3-7, 20-22 and 24-30, is actually a method limitation entitled to no patentable weight in applicant's product claims.

The use of a filler layer to effectuate a bond between two cured sheets of surimi, as occurs in Nakajima, does not lead away from applicant's claimed invention, despite applicant's belief to the contrary, especially since such a filler layer or any other type of bond is not precluded by any of applicant's claims. The means by which applicant's films are created would be the proper subject of method claims but is entitled to no patentable weight in the instant product claims.

Applicant's comments with respect to the 35 U.S.C. 112 rejection of claim 7 are not convincing since, according to the article submitted with applicant's October 11, 2005 response, the proper unit for gel strength is "g.cm" and not "g/cm" as claimed by applicant.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur L Corbin
Primary Examiner
Art Unit 1761
8-1-06